



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/583,850

06/21/2006

Yasuhiro Suzuki

Q95384

8580

23373 7590 09/22/2008
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT

PAPER NUMBER

3618

MAIL DATE

DELIVERY MODE

09/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/583,850 | Applicant(s) SUZUKI ET AL. | |
| | Examiner Frank B. Vanaman | Art Unit 3618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/21/06</u> . | 6) <input type="checkbox"/> Other: ____. |

Information Disclosure Statement

1. The information disclosure statement filed June 21, 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the certain of the references referred to therein have not been considered. In the searching of the application, the examiner has located a number of the cited references (WO02083446 and JP 7-279987), and as such, those references are indicated as having been considered.
2. The listing of references in the specification (see pages 4-5) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

3. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b) which sets forth the requirements for an abstract of the disclosure.
4. The disclosure is objected to because of the following informalities: specific references to the content of specific claims (see page 7, line 21) should be avoided.
Appropriate correction is required.

Claim Objections

5. Claims 1, 2 and 4 are objected to because of the following informalities: In claim 1, line 9 and claim 4, line 9, it appears as though "the rotating side case" should be --a rotating side case--; in claim 2, line 4, it appears as though "the side faces" should be --side faces--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagaya (WO 02083446, cited by applicant). Nagaya teaches an in-wheel motor system having a hollow direct drive motor (3) which is provided in a wheel or hub (1 and/or 2), the motor stator (3S) being supported to a part around the wheel (5, 6, and/or 7) of the vehicle by elastic bodies and/or an attenuation mechanism (14a), the motor rotor (3R) and wheel or hub (1, 2) being interconnected by a coupling mechanism (18) comprising a wheel-side plate (18A) connected to the wheel or hub, a motor-side plate (18C) connected to a rotating side case portion (3B of 3R) of the motor, an intermediate plate (18B) interposed between and connected with the wheel and motor plates by slide members (18P, 18Q) which are provided with roller bearing members (18M) which are limited to move in mutually perpendicular directions (see figure 18) by contact portions (e.g., lateral roller-embracing side portions of 18Y and/or internal projecting portions of 18X) which extend in the direction of the roller members (e.g., parallel to the arrows, figure 19) and engage either the external or internal lateral sides of the rollers, and/or (as more particularly directed to claim 4) where the perpendicular directions are set by guide members (18X, 18Y) at least one of which (18X) includes a protruding rail or rod section which is mutually engaged with a mating recess (middle portion of 18Y) in the other member, and with the bearing elements (18M).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3618

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaya in view of Asai (JP H07-279987, cited by applicant). The reference to Nagaya is discussed above and fails to teach the provision of an elastic annular dust boot containing the slide members. Initially, the examiner notes that it is very old and notoriously well known to provide dust boots to cover various working portions of a vehicle which would benefit from being isolated from dust, dirt or other contaminants. Further, Asai teaches that it is well known to provide an elastic annular dust boot (6) to cover multiple plate elements (1, 2, 3) which are used in rotary force transmission. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the connections taught by Nagaya with an annular elastic dust boot as taught by Asai for the well known purpose of protecting the slide mechanisms and thus ensuring a longer life for the force transmitting coupling (18) in general. Such an application sees notable benefit for at least protecting the mechanism, such that it need not be replaced as soon as an unprotected mechanism, ensuring longer life and reducing costs associated with replacement or repair of failed parts.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tenney (US 1,780,370), Edwards (US 3,347,333), Yamashita et al. (US 5,150,763), Bachmann (US 6,752,227), and Nagaya (US 7,306,065, and US PGPub 2006/0048978) teach vehicle structures of pertinence.

11. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

Art Unit: 3618

access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,

Or faxed to:

PTO Central Fax: 571-273-8300

F. VANAMAN
Primary Examiner
Art Unit 3618

/Frank B Vanaman/
Primary Examiner, Art Unit 3618